

## REMARKS

Claims 1-45 are pending in the application. The Examiner objects to claims 2, 6, 7, 9, 12-14, 21, 22, 24, 27-30, 36-39 and 42-45 as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the Examiner's objections. Claims 1, 3-5, 8, 10, 11, 16-20, 23, 25, 26, 31-35, 40 and 41 are rejected. Claims 10, 25 and 40 would be allowable if rewritten to overcome the rejection(s) under 35 USC § 112, 2<sup>nd</sup> paragraph. The drawings filed July 22, 2004 are accepted. The Examiner's objections and rejections are addressed below in substantially the same order as in the office action.

### **REJECTIONS UNDER 35 USC § 112**

Claims 10, 25 and 40 stand rejected as being indefinite because each of the claims recited the limitation "the tool draw rate" in their last lines, respectively. Applicant has deleted the word "tool" to remove the antecedent basis problem noted by the Examiner.

### **REJECTIONS UNDER 35 USC § 102**

Claims 1, 3-5, 8, 11, 16-20, 23, 26, 31-35 and 41 stand rejected under 35 USC § 102(e) as being anticipated by Hill et al. (US 6,964,301).

To Applicant's reading, Hill et al teaches a tool for extracting fluid from a subsurface formation. Hill et al teaches that the flow of fluid into the tool may be selectively adjusted to optimize the flow of fluid into the channels and that the flow rates may be automatically adjusted by a controller or manually manipulated to further optimize the fluid flow. (Abstract). In the paragraph cited by the Examiner, Hill et al further explains the flow rate may be altered to affect the flow of fluid and optimize the intake of virgin fluid into the downhole tool, to increase the efficiency of the sampling process and the quality of the sample. (col. 9, lines 42-53).

With respect to independent claims 1, 16, and 31. Hill et al does not teach or suggest determining at least one characteristic of the test volume during one or more of the first draw portion and the second draw portion. As discussed above, Hill et al. adjusts flow rate only for reasons relating to tool efficiencies and sample quality. Hill et al. does not adjust flow rate to determine a characteristic indicative of a formation parameter. Because Hill et al. does not teach the determining step of these claims, Hill et al. does not teach each and every recitation of claims 1, 16 and 31. Thus, Applicant respectfully submits that independent claims 1, 16, and 31 are in condition for allowance.

With respect to claims 8, 11, 23, 26, and 41, as discussed above Hill et al does not teach or suggest determining a characteristic indicative of a formation parameter during a first draw portion or a second draw portion. Because these claims are directed to one or more aspects of such a determination, Applicant respectfully submits that claims 8, 11, 23, 26, and 41 are in condition for allowance.

With respect to claims 3-5, 17-20, 32-35, each of these claims depend from an independent claim that is believed to be in condition for allowance and are allowable on at least those grounds.

#### **ALLOWABLE SUBJECT MATTER**

Claims 2, 6, 7, 9, 12-14, 21, 22, 24, 27-30, 36-39 and 42-45 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

Claim 12 has been rewritten in independent form using some, but not all, of the recitations of independent claim 1. Applicant believes that amended claim 12 nevertheless is neither anticipated nor obviated by the prior art of record.

Claim 27 has been rewritten in independent form using some, but not all, of the recitations of independent claim 16. Applicant believes that amended claim 27 nevertheless is neither anticipated nor obviated by the prior art of record.

Claim 42 has been rewritten in independent form using some, but not all, of the recitations of independent claim 31. Applicant believes that amended claim 42 nevertheless is neither anticipated nor obviated by the prior art of record.

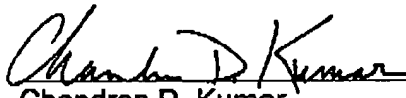
Claims 2, 6, 7, 9, 13-14, 21, 22, 24, 28-30, 36-39 and 43-45 have not been rewritten in independent form because these claims depend from claims Applicant believes are in condition for allowance.

### **CONCLUSION**

For all the foregoing reasons, Applicant submits that the application is in a condition for allowance. No fee is believed due for this paper. The Commissioner is hereby authorized to charge the fee of \$1,020 for a three month extension of time (attached) to Deposit Account No. **02-0429 (414-35587-USCP)** maintained by Baker Hughes Incorporated. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. **02-0429 (414-35587-USCP)**.

Respectfully submitted,

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### **CERTIFICATE OF FACSIMILE TRANSMISSION**

I do hereby certify that this correspondence is being transmitted via facsimile, to the Commissioner for Patents, Examiner John P. Fitzgerald, facsimile no. (571) 273-8300, on this 15th day of June, 2006.

  
Beth Pearson-Naul